

Sub P. 5
79. (New) The combination of claim 77 wherein the housing comprises a handle portion with a direction of elongation and the direction of sliding is generally perpendicular to the direction of elongation.

REMARKS

An Office action was mailed by the Patent Office August 16, 2002. Claims 1-35 were pending at the time of the Office action. Claims 1-12 were rejected under 35 U.S.C. § 251 for "a lack of 'reissuable error.'" Claims 13-20 were rejected under 35 U.S.C. § 112, ¶1 for lacking a written description of the claimed subject matter, and under 35 U.S.C. § 251 for containing new matter. Claims 21-35 were allowed.

After entry of the above amendment, claims 1-79 will be pending in the application. New claims 36-79 are added to the application by the present amendment. New claims 36-42 depend from claim 13. New claims 43-46 depend from allowed claim 21. New claim 47 is independent and claims 48-62 depend therefrom. New claim 63 is independent and claims 64-70 depend therefrom. New claim 71 is independent and claims 72-79 depend therefrom.

Rejection of Original Patent Claims 1-12

Claims 1-12 were rejected in the Office Action for an alleged "lack of 'reissuable error.'" See Office action of August, 16, 2002, page 2. As best understood, the reasoning for this rejection is that because the original claims were not amended, they do not contain an error, and because they do not contain an error, they are not eligible to be reissued in the present reissue application.

On the assumption that the above is the reasoning for this rejection, the Patentee respectfully traverses this rejection. While it is true that a reissue application cannot be granted without a defect in the original patent, the Patentee has met the burden of establishing the existence of a defect. Namely, the defect, as set forth in the declaration for the reissue patent, is that the patent claimed less than the applicants were entitled to claim (*i.e.*, the claims were too narrow). The Patentee intends to remedy this defect by seeking new patent claims that are broader in certain respects than the original patent claims. At the same time, the Patentee also wishes to have the original patent claims included in the reissue patent, in their unamended form, because they will provide a set of claims of different scope than the new claims.

The Patentee is aware of no reason, by virtue of statute or Patent Office rule, why a reissue patent cannot contain claims identical to the claims in the original patent. In fact, it has been standard practice at the U.S. Patent and Trademark Office to allow the original, unamended patent claims to be reissued in the reissue patent. This is evidenced by numerous examples of this practice in existing U.S. reissue patents, such as Re35,746 which was granted in 1998 with each of the twenty original, unamended claims from the original patent by the same Examiner as in the present application. *See* U.S. Patent No. Re35,746, Exhibit A hereto.

Because the original patent has already been shown to contain a defect sufficient to warrant reissue of the patent, the Patentee respectfully traverses the rejection of claims 1-12 and solicits a withdrawal of that rejection.

Rejection of Claims 13-20 Under 35 U.S.C. § 112, ¶1, and 35 U.S.C. § 251

Claim 13 was rejected under 35 U.S.C. § 112, ¶1 for allegedly lacking an adequate written description of the claimed subject matter, and under 35 U.S.C. § 251 for allegedly containing new matter. Claims 14-20 depend from claim 13 and were likewise rejected. The limitation of claim 13 which allegedly lacks an adequate written description and contains new matter recites “one of the drive assembly and the battery having a pair of tracks defining flanges; and the other of the drive assembly and the battery having grooves configured to receive the flanges of the tracks....”

In the Office action, the Examiner stated that “...there is no support in the present specification for the battery having flanges or for the drive assembly having grooves. The specification only supports the drive assembly having the flanges and the battery having the grooves.” *See* Office action of August 16, 2002, page 2. The Examiner also stated that claiming a battery with flanges and a drive assembly with grooves is new matter. *Id.* The Patentee respectfully traverses these rejections.

The Patentee respectfully submits that: (i) a battery with flanges and a drive assembly with grooves are in fact disclosed in the original drawing figures of the original application from which this reissue application derives priority (U.S. Patent Application Serial No. 08/258,338, filed June 10, 1994, hereinafter “Parent Patent Application”); and (ii) the depiction of a battery with flanges and a drive assembly with grooves in the drawings of the application is an adequate written description. Reasoning supporting each of these assertions follows.

It is well settled law that the original drawings constitute part of the original disclosure in a patent application and can be relied upon to support details of the invention which are later added by amendment to the specification and the claims. The MPEP § 608.04(a) states that new matter is matter not in the original specification, claims, or *drawings*. *See also Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1559 (Fed. Cir. 1991) (“[U]nder proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by § 112”); *Ex parte Horton*, 226 U.S.P.Q. 697, 699 (Bd. Pat. Appeals 1985); *In re Wolfensperger*, 302 F.2d 950 (C.C.P.A. 1962).

In *Wolfensperger* (Exhibit B hereto), the U.S. Court of Customs and Patent Appeals was faced with the issue of whether the original drawing figures in Wolfensperger’s patent application could provide support to matter which Wolfensperger desired to add by amendment to the specification and to the claims. *Wolfensperger* involved a patent application for a spherical ball valve. The applicant sought to amend the specification and claims to include details regarding the relative size of some of the O-rings situated in the valve. The applicant was seeking to add these limitations to the claims in order to copy claims from another patent and provoke an interference.

The question before the *Wolfensperger* court was whether the details about the sizes of the O-rings were supported by the original disclosure, or whether they constituted new matter. Admitting that the specification did not directly discuss the relative size of the O-rings, Wolfensperger asserted that the size limitations were apparent in the illustrations of the O-rings in the drawings and the disclosure as a whole. Tellingly, the Court stated:

The issue here is whether there is supporting 'disclosure' and it does not seem, under established procedure of long standing, approved by this court, to be of any legal significance whether the disclosure is found in the specification or in the drawings so long as it is there.

Id., 302 F.2d at 956. The *Wolfensperger* court also observed that:

The practical, legitimate enquiry in each case of this kind is what the drawing in fact discloses to one skilled in the art. Whatever it does disclose may be added to the specification in words without violation of the statute and rule which prohibit 'new matter,' 35 U.S.C. § 132, Rule 118, for the simple reason that what is originally disclosed cannot be "new matter" within the meaning of the law.

Id., 302 F.2d at 955.

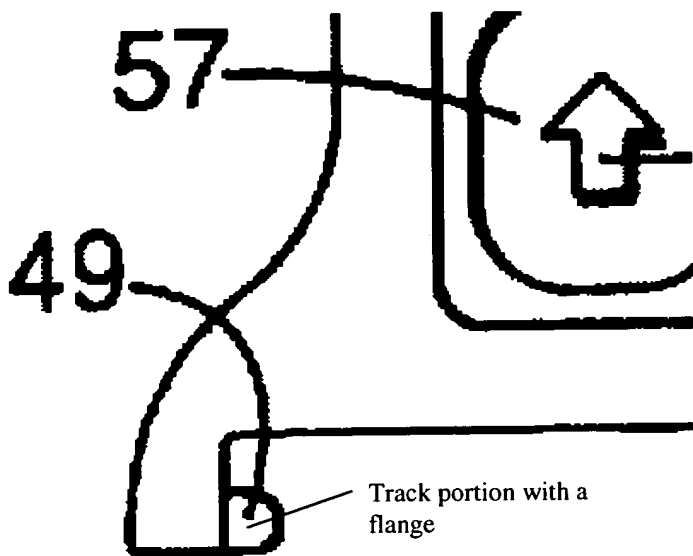
Wolfensperger has been followed by both the Board of Patent Appeals and Interferences, *see Ex parte Horton*, 226 U.S.P.Q. at 699 ("...it is well settled that drawings may be relied upon to satisfy the disclosure requirements of 35 USC 112," citing *In re Wolfensperger*) (Exhibit C hereto), and more recently by the Court of Appeals for the Federal Circuit, *see Vas-Cath Inc.*, 935 F.2d at 1565 ("These cases support our holding that, under proper circumstances, drawings alone may provide a 'written description' of an invention as required by § 112," also citing *In re Wolfensperger*) (Exhibit D hereto).

(i) A Battery With Flanges and a Drive Assembly With Grooves Is in Fact Disclosed in the Original Drawing Figures of the Parent Patent Application

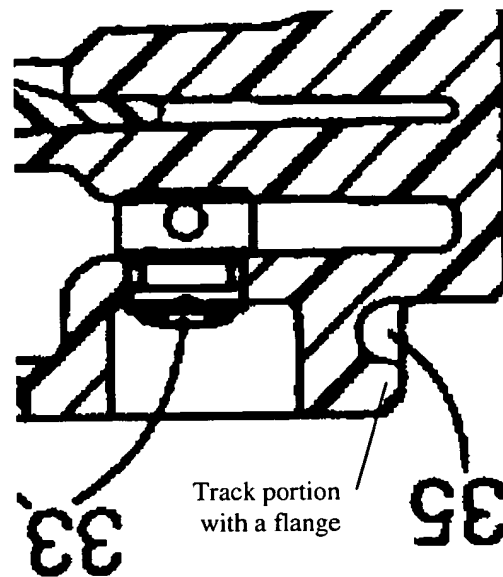
The specification of the Parent Patent Application teaches that mounting grooves 35 can be formed on the battery 30 and that track portions 49 with flanges can be formed on the battery receiving portion 48 of the drive assembly housing. *See, e.g.*, specification of the '573 patent, col. 11, lines 40-47 (for expedience, this Response refers to the specification and drawings of the '573 patent rather than to those of the Parent Patent Application). FIGS. 4 and 6 in the '573

patent illustrate the structures which the specification defines as the track portions 49 with flanges and the mounting grooves 35.

Illustrated below are enlarged side-by-side portions of FIGS. 4 and 6 of the '573 patent. The view from FIG. 6 has been flipped up-side-down to facilitate a side-by-side comparison of the structure in FIG. 4 with the structure in FIG. 6. The detail view from FIG. 4 clearly illustrates the structure of a track portion 49 with a flange.¹ An annotation has been added to designate this structure. As is readily apparent, the same structure in FIG. 4 that is indicated as a track portion 49 with a flange is also depicted in FIG. 6 on the battery 30. The identical depiction of the track portion with a flange structure on the battery 30 is indicated with an annotation.



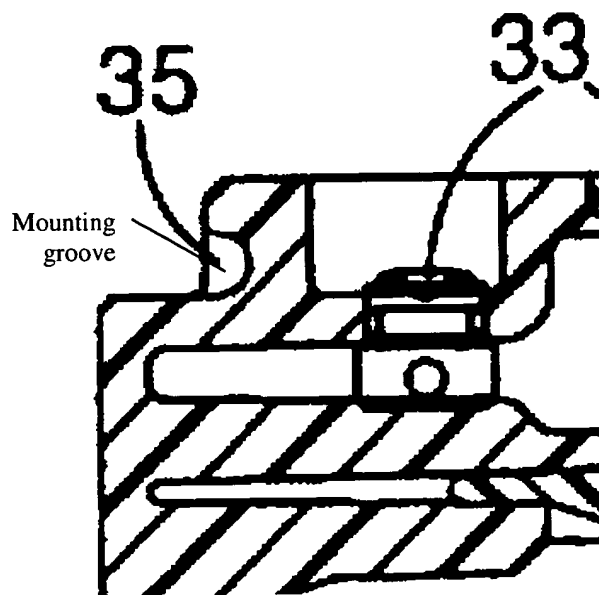
Enlarged detail view from FIG. 4
of the '573 patent



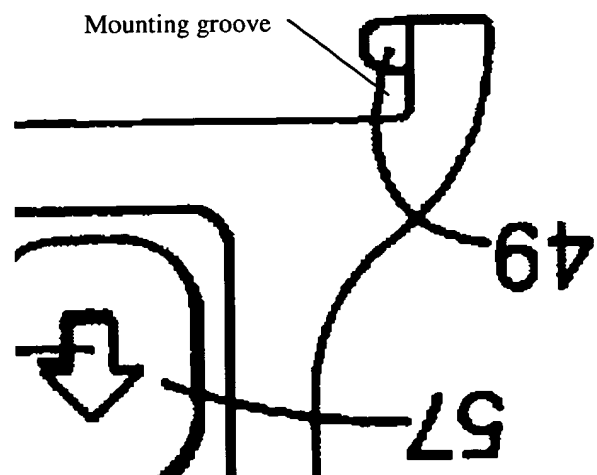
Enlarged detail view from FIG. 6
of the '573 Patent

¹ The cut-away, sectional portion of the battery 30 shown in FIG. 4 has been removed in this view to more clearly focus on the track portion 49 with a flange.

Turning now to the mounting grooves 35, once again, illustrated below are enlarged side-by-side portions of FIGS. 4 and 6 of the '573 patent. This time the view from FIG. 4 has been flipped upside-down to facilitate a side-by-side comparison of the structure in FIG. 6 with the structure in FIG. 4.² The detail view from FIG. 6 of the '573 patent clearly illustrates the structure of a mounting groove 35. An annotation has been added to designate this structure. As is readily apparent, the same structure in FIG. 6 that is indicated as a mounting groove is also depicted in FIG. 4 on the battery receiving portion of the drive assembly. The identical depiction of the mounting groove structure on the battery receiving portion of the drive assembly is indicated with an annotation.



Enlarged detail view from FIG. 6
of the '573 patent



Enlarged detail view from FIG. 4
of the '573 patent

² The cut-away, sectional portion of the battery 30 in FIG. 4 has been removed in this view to more clearly focus on the relevant structure.

As these side-by-side depictions of FIGS. 4 and 6 demonstrate, *a battery with flanges and a drive assembly with grooves are in fact shown in the drawings*. Therefore, the recitation of a battery with flanges and a drive assembly with grooves as recited in independent claim 13 is not new matter.

According to *Wolfensperger* and its progeny, the practical question in this inquiry is whether a person of ordinary skill in the art would have understood from the disclosure (including the drawings) that the flanges could be included on the battery and the grooves on the drive assembly. In the present case, it is respectfully submitted that a person of ordinary skill in the art would understand this because, as explained above, this arrangement is depicted in FIGS. 4 and 6 of the '573 patent.

Furthermore, it is readily apparent to a person of skill in the art viewing FIG. 4 of the '573 patent that the preferred exemplary tool and battery depicted contain nearly identical complementary interlocking structures (though the complementary interlocking structures need not be identical). This is easily confirmed by turning FIG. 4 upside-down and seeing that the complementary interlocking structure holding the battery to the tool looks up-side-down almost the same as it does right-side-up. A person of ordinary skill in the art, then, would immediately understand that the complementary interlocking structure could be viewed as a groove included on the battery interlocking with a flange formed on the tool, or as a groove included on the tool interlocking with a flange formed on the battery, or both. This proposition does not require a great deal of imagination or interpretation of FIG. 4—a person of ordinary skill in this art would readily understand this.

Finally, there is no disclosure in the specification as a whole which precludes the flanges from being formed on the battery and the grooves from being formed on the drive assembly. FIGS. 4 and 6, in fact, depict this arrangement.

Thus, the drawing figures not only depict track portions 49 with flanges formed on the drive assembly that are received in mounting grooves 35 formed on the battery, but they also depict track portions with flanges formed on the battery that are received in mounting grooves formed on the drive assembly. Because arranging flanges on the battery and grooves on the drive assembly would clearly be recognized and understood by a person of ordinary skill in the art from the disclosure, it is not new matter to recite this arrangement in the claims.

For all of the foregoing reasons, the Patentee respectfully requests that the rejection of claims 13-20 for containing new matter be withdrawn.

(ii) The Depiction of a Battery With Flanges and a Drive Assembly With Grooves In the Drawings of the Application Is an Adequate Written Description

Claim 13 was also rejected for allegedly lacking an adequate written description of a battery with flanges and a drive assembly with grooves. As has been explained above, FIGS. 4 and 6 of the '573 patent depict a battery with flanges and a drive assembly with grooves. In *Vas-Cath*, 235 F.2d at 1555 (Exhibit D), the Court of Appeals for the Federal Circuit was faced with the question of whether the drawings from a design patent application provided sufficient "written description" under 35 U.S.C. § 112, ¶1 so that a later filed utility patent application could claim the benefit of the filing date of the design application under 35 U.S.C. § 120 (a prerequisite to claiming priority under § 120 is that the invention be described in the earlier

application in a manner consistent with the requirements of 35 U.S.C. § 112). The Court described the purpose of the written description requirement found in 35 U.S.C. § 112, ¶1 as follows:

The purpose of the “written description” requirement is broader than to merely explain how to “make and use”; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the “written description” inquiry, *whatever is now claimed*. (emphases in original)

Vas-Cath, 935 F.2d at 1563-64. The Court then held “... under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by § 112.” *Id.*, 935 F.2d at 1565.

It has been shown above that the drawing figures in this application do in fact illustrate a battery with flanges and a drive assembly with grooves. The drawing figures effectively demonstrate that the inventors were in possession of the invention recited in claim 13 at the time the original patent application was filed on June 10, 1994. Therefore, withdrawal of the rejection under 35 U.S.C. § 112 is respectfully requested.

Nevertheless, should the Examiner believe it appropriate, the Patentee will amend the specification to contain a specific reference to the battery with flanges and the drive assembly with grooves as clearly illustrated in FIGS. 4 and 6 of the application.

New Claims

New claims 36-79 are added to the application by the present amendment. New claims 36-42 depend from claim 13. New claims 43-46 depend from allowed claim 21. New claim 47

is independent and claims 48-62 depend therefrom. New claim 63 is independent and claims 64-70 depend therefrom. New claim 71 is independent and claims 72-79 depend therefrom.

For the convenience of the Examiner, the Patentee is providing a claim chart (Exhibit E) with citation to the appropriate supporting disclosure for each new claim added by this amendment. The references to the supporting disclosure in the claim chart are not intended to be exhaustive, and for convenience, the Patentee has provided citation to the '573 patent specification and drawings rather than to those in the Parent Patent Application filed on June 10, 1994. It is respectfully submitted that each of these new claims is supported by the disclosure and contains no new matter.

CONCLUSION

Patentee respectfully submits that the claims are in condition for allowance, an indication of which is respectfully requested. If there are any remaining issues, the Examiner is invited to telephone the undersigned representative with any suggestions leading to the favorable disposition of the application.

This Response is submitted less than four months from the mailing date of the Office action. A Petition for a One Month Extension of the Period for Reply, thus extending the period of reply to four months, and the appropriate fee, accompanies this Response. In addition, a fee for the additional claims that are added to the application by the present amendment accompanies this Response. If any further fees are due in connection herewith, or at any time during the

pendency of this patent application, authorization is hereby granted to charge the undersigned's deposit account no. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS

Dated: 12/16/2002

By:

Christopher C. Campbell
Christopher C. Campbell
Registration No. 37,291

Hunton & Williams
Intellectual Property Department
1900 K Street, N.W., Suite 1200
Washington, D.C. 20006-1109
(202) 955-1672 (Telephone)
(202) 778-2201 (Facsimile)